

REMARKS

Claims 1-7 and 9-25 are pending in this application after this Amendment. Claims 1, 2, 4, 5, 9, 11, 12, 15, 17, 23, and 24 are independent. In light of the remarks contained herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1, 5, 10, 12, 14, and 17 under 35 U.S.C. §103(a) as being unpatentable over *Watanabe et al.* (USP 5,953,481) in view of *Steinberg et al.* (USP 5,862,217); rejected claims 2, 9, 11, 15 and 19 under 35 U.S.C. 103(a) as being unpatentable over *Watanabe et al.* in view of *Steinberg et al.* and further in view of *Matsumoto et al.* (USP 5,796,428); rejected claims 3, 4, 7, 13, and 16 under 35 U.S.C. 103(a) as being unpatentable over *Watanabe et al.* in view of *Steinberg et al.* and further in view of *Freeman et al.* (USP 5,579,239); rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over *Watanabe et al.* in view of *Steinberg et al.* and *Matsumoto* and further in view of *Freeman*; and rejected the remainder of the claims using a combination of references. Applicants respectfully traverse these rejections.

Claims Rejections Under - 35 U.S.C. § 103 – *Watanabe et al./Steinberg et al.*

In support of the Examiners rejection of claim 1, the Examiner asserts that *Watanabe et al.* discloses all the elements as recited in the claim except that the wireless communication device transmits image data. The Examiner relies on *Steinberg et al.* to cure the deficiencies of the teachings of *Watanabe et al.* citing that figure 1; col. 2, lines 49-64 and column 3, lines 31-35. The Examiner asserts that it would have been obvious to one skilled in the art that the image data transmitted by *Watanabe et al.* would be transmitted wirelessly in the matter taught by *Steinberg et al.* so that communication would be made easier by being assessable in areas where standard lines are inaccessible. Applicants respectfully disagree that there is sufficient motivation to modify *Watanabe et al.* as asserted by the Examiner.

Watanabe teaches away from the purported combination as asserted by the Examiner. *Watanabe* seeks to provide a reproducing apparatus which can be produced at a low cost and which is simply operable for carrying out an editing function for editing information signals

recorded on a recording medium. (*Watanabe*, col. 5, lines 43-48). By modifying the devices disclosed in *Watanabe et al.* to permit wireless communication between the camera-integrated type VTR and the stationary VTR, substantial modification to both devices would need to be made, thus increasing the cost. Increased cost is the exact problem that *Watanabe et al.* was trying to avoid. As such, *Watanabe et al.* teaches away from the purported modification.

The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the image data transmitted by *Watanabe et al.* would be transmitted wirelessly, in the manner taught by *Steinberg*, so communication would be made easier by being accessible in areas where standard lines are inaccessible. This motivation is not found in any of the references currently cited. It appears that the Examiner extracts this motivation from *Freeman*, col. 9, lines 25-35, where *Freeman* comments that the remote unit 2 is designed to preferably include cellular telephones to allow transmission of files from areas, which are inaccessible to standard telephone lines. It is well established that the teaching or suggestion to make the asserted combination or modification of the primary reference must be found in the prior art and cannot be gleaned from Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As *Freeman* is not cited in the outstanding rejection, it is wholly improper for the Examiner to rely on its teachings to support the Examiner's proposed modification of *Watanabe et al.* As neither of the references support the purported motivation, Applicants respectfully submit that there is no motivation to use the teachings of *Steinberg* in combination with the teachings of *Watanabe et al.* It is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. §103.

Further, by asserting that it would have been obvious to modify *Watanabe et al.* with the teachings of *Steinberg* with no suggestion or motivation in the applied references, or elsewhere, to do so, the rejection appears to rely on impermissible hindsight.

The Examiner's reliance on the same motivation from *Freeman* to modify *Watanabe et al.* has already been previously decided by the Board of Appeals, and, as such, is prohibited by *res judicata* and collateral estoppel. In the Decision by the Board of Appeals mailed December

28, 2005, the Board decided that there was no motivation to modify *Watanabe et al.* to permit transmission of image data wirelessly (See pages 6 and 8 of Decision). As the Board of Appeals has already decided this issue, Applicants respectfully submits that the reassertion of this statement of motivation in support of the modification of Watanabe et al. is wholly improper.

By this amendment, Applicants have added new claim 25 for consideration by the Examiner. Applicants respectfully submit that claim 3 is allowable for the reasons set forth above with regard to claim 1 at least based its dependency on claim 1. In addition, Applicants respectfully submit that none of the cited references, either alone or in combination, teach or suggest enciphering as claimed, together with all of the other elements set forth in claim 25.

It is respectfully submitted that the Examiner relies on the same motivation for combining Watanabe et al. and Steinberg for all of claims 1, 2, 4, 5, 9, 11, 12, 15, 17, 24 and 24. However, for at least one of the reasons noted above, Applicants respectfully submit that the Examiner's rejections of these claims, together with claims dependent thereon, are improper and should be withdrawn.

Conclusion

For all of the reasons set forth above, it is respectfully requested that the outstanding rejection be withdrawn. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinnet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 09/933,197
Amendment dated August 8, 2006
Reply to Office Action of May 8, 2006

Docket No.: 0879-0346P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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